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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,832	04/07/2004	Sean Christopher Endler	Sony-07100	8497
7590 03/20/2008				
Valley Oak Law 5655 Silver Creek Valley Road, #106 San Jose, CA 95138				
EXAMINER				
BERMAN, BRIAN J				
ART UNIT		PAPER NUMBER		
4194				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/820,832

**Applicant(s)**

ENDLER ET AL.

**Examiner**

BRIAN BERMAN

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-30 is/are rejected.  
7) ☒ Claim(s) 18-30 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 4/11/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of the claims**

Claims 1-30 are now pending in the Instant Application.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by Examiner.

### **Claim Objections**

Claims 18-30 are objected to because of the following informalities:

There is no claim 17. Claim 17 is missing. For purposes of examination, claim: 18 is renumbered as 17, 19 is renumbered as 18, 20 is renumbered as 19, 21 is renumbered as 20, 22 is renumbered as 21, 23 is renumbered as 22, 24 is renumbered as 23, 25 is renumbered as 24, 26 is renumbered as 25, 27 is renumbered as 26, 28 is renumbered as 27, 29 is renumbered as 28, and 30 is renumbered as 29.

The claims need to be renumbered as stated above. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

Claims 1-13, 16-20, 23-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Jokinen et al. (hereinafter Jokinen), US Patent 7,343,317 B2.

**Concerning Claim 1**, Jokinen discloses the invention as claimed, including:

A method comprising:

detecting a device; (Summary of Invention, abstract)

searching for a plurality of promotions; (col 6, lines 51-55)

detecting a profile corresponding to the device wherein the profile contains a parameter; and (col 5, lines 18-24)

selecting a particular promotion from the plurality of promotions based on the parameter associated with the profile. (col 5, lines 41-55, col 6, lines 3-6)

**As to Claim 2**, Jokinen further discloses

The method according to claim 1 further comprising detecting a location of the device. (col 5,

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lines 25-35; abstract)

**As to Claim 3**, Jokinen further discloses

The method according to claim 2 wherein selecting the particular promotions is based on the location of the device. (col 5, lines 25-35; col 6, lines 3-6)

**As to Claim 4**, Jokinen further discloses

The method according to claim 1 wherein the parameter includes a preference for a product. (col 5, lines 55-60)

**As to Claim 5**, Jokinen further discloses

The method according to claim 1 wherein the parameter includes a preference for a service. (col 5, lines 55-60)

**As to Claim 6**, Jokinen further discloses

The method according to claim 1 wherein the parameter includes a geographic boundary.  
(abstract)

**As to Claim 7**, Jokinen further discloses

The method according to claim 1 further comprising detecting a profile for each of the plurality of promotions. (col 8, lines 16-20)

**As to Claim 8**, Jokinen further discloses

The method according to claim 7 wherein the profile for each of the plurality of promotions includes location information. (col 8, line 20)

**As to Claim 9**, Jokinen further discloses

The method according to claim 7 wherein the profile for each of the plurality of promotions includes a description of offerings. (col 6, line 19)

**As to Claim 10**, Jokinen further discloses

The method according to claim 7 wherein the profile includes days and time of validity for each of the plurality of promotions. (col 8, line 28)

**As to Claim 11**, Jokinen further discloses

The method according to claim 7 wherein selecting the particular promotion is based on profile

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for each of the plurality of promotions. (col 8, lines 47-51)

**As to Claim 12**, Jokinen further discloses

The method according to claim 1 further comprising displaying the particular promotion on the device. (abstract)

**As to Claim 13**, Jokinen further discloses

The method according to claim 1 further comprising highlighting the particular promotion prior to an expiration of the particular promotion. (col 10: 65-67, Fig 6, element 112, e-coupon alarms user before expiration time, date)

**As to Claim 16**, Jokinen discloses the system for implementing the method of claim 1. (see discussion of claim 1)

**As to Claim 17**, Jokinen discloses the invention as claimed, including:

A method comprising:

detecting a plurality of devices; (claims 5-8)

identifying a location for a meeting among the plurality of devices; (col 5, lines 33-39; col 7, lines 40-49)

searching for a plurality of promotions; and (col 6, lines 51-55)

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selecting a particular promotion from the plurality of promotions based on the location of the meeting. (col 6, lines 3-6; col 5, lines 18-24; col 5, lines 41-47; col 8, line 48)

Here, Jokinen discloses a method for detecting the presence of a plurality of mobile devices within a vicinity or geographic location (meeting location of the users), querying or searching a database storing a plurality of targeted promotions (advertisements and coupons) and selecting a particular promotion, based at least on the geographic location (meeting location) of the mobile devices, from the plurality of stored promotions and providing the promotion or a coupon to the users of the mobile devices, the value of which is computed based on the number of mobile devices currently present in the vicinity. (Jokinen, claims 5-8, col 12, lines 54-60; col 14, lines 32-37; Summary of Invention; col 5, lines 33-39; col 7, lines 40-49)

**As to Claim 18**, Jokinen further discloses

The method according to claim 18 wherein selecting the particular promotion is based on a time of the meeting. (col 7, lines 42-49; col 8, line 29)

**As to Claim 19**, Jokinen further discloses

The method according to claim 18 wherein selecting the particular promotion further comprises matching the location with the particular promotion such that the particular promotion is utilized



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at the location. (col 7, lines 44-49, e-coupon is used at store, col 1, lines 64-67, col 13, 25-30)

**As to Claim 22**, Jokinen further discloses

The method according to claim 18 further comprising detecting a current location for each of the plurality of devices. (col 5, lines 22-30; col 8, line 48)

**As to Claim 23**, Jokinen discloses the invention as claimed, including:

A system, comprising:

a device detection module to detect a device associated with a user; (col 14, lines 6-25; col 5, lines 18-30)

a storage module to store a device record containing user information associated with the user and a promotion record containing promotion information associated with a promotion; and (col 5, line 43; col 6, line 19)

a promotion location selection module to select a particular promotion based on the user information and the promotion information. (col 8, lines 48-51, claim 11)

**As to Claim 24**, Jokinen further discloses

The system according to claim 24 wherein the user information includes a user preference for a product. (col 5: lines 55-60)

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**As to Claim 25**, Jokinen further discloses

The system according to claim 24 wherein the user information includes a user preference for a service. (col 5: lines 55-60)

**As to Claim 26**, Jokinen further discloses

The system according to claim 24 wherein the user information includes a geographic boundary.  
(abstract)

**As to Claim 27**, Jokinen further discloses

The system according to claim 24 wherein the promotion information includes a time and data validity. (col 8, line 28)

**As to Claim 28**, Jokinen further discloses

The system according to claim 24 wherein the promotion information includes location information. (col 8, line 20)

**As to Claim 29**, Jokinen discloses the invention as claimed, including:

A computer-readable medium having computer executable instructions for performing a method comprising: (col 7, lines 15-25)

detecting a plurality of devices; (claims 5-8)

identifying a location for a meeting among the plurality of devices; (col 5, lines 33-39; col 7, lines 40-49)

searching for a plurality of promotions; and (col 6, lines 51-55)

selecting a particular promotion from the plurality of promotions based on the location of the meeting. (col 6, lines 3-6; col 5, lines 18-24; col 5, lines 41-47; col 8, line 48)

Here, Jokinen discloses a system for detecting the presence of a plurality of mobile devices within a vicinity or geographic location (meeting location of the users), querying or searching a database storing a plurality of targeted promotions (advertisements and coupons) and selecting a particular promotion, based at least on the geographic location (meeting location) of the mobile devices, from the plurality of stored promotions and providing the promotion or a coupon to the users of the mobile devices, the value of which is computed based on the number of mobile devices currently present in the vicinity. (Jokinen, col 14, lines 32-37, Summary of Invention, col 5, lines 33-39; col 7, lines 40-49)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 14, 15, 20, and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokinen et al. (hereinafter Jokinen), US Patent 7,343,317 B2.

**Concerning Claim 14**, Jokinen discloses the invention substantially as claimed.

Jokinen does not teach the step wherein the device is associated with a particular user. However, Official Notice is taken that a device being uniquely associated (such as with a unique serial number associated with the mobile device) with a particular user has been known as a basis to keep track of that particular user, such as for marketing purposes. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Jokinen* with the commonly recognized practice of using unique serial numbers (or customer identifiers) associated with the mobile devices of the consumer as a validation and authentication technique. The rationale would have been so companies can keep track of a user's purchases for marketing purposes, such as to send targeted advertisements to the user in the future.

**Concerning Claim 15**, Jokinen discloses the invention substantially as claimed.

Jokinen does not teach the step wherein the device is associated with multiple users. However, Official Notice is taken that the use of multiple users using the same mobile device (such as a family sharing a cell phone) has been known as a basis to save money for a group of

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people (such as a family). Since there are multiple people using the same mobile device, each person has a different client identifier (user name) and password. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Jokinen* with the commonly recognized practice of using passwords and affirming the ID information of each user (of a group) as a validation and authentication technique. The rationale would have been to make sure that the person is the authorized consumer who is entitled to use the mobile device, such as to make purchases and receive discounts from the mobile device.

**Concerning Claim 20**, *Jokinen* discloses the invention substantially as claimed.

*Jokinen* does not teach the step wherein selecting the particular promotion further comprises matching the location with the particular promotion such that the particular promotion is utilized at a competing location.

However, Official Notice is taken that the use of sending advertisements to people to use at a competitor has been known as a basis for the competitor to easily target customers who are likely to purchase competitor's products or services. At a grocery store, when a person buys one brand of beverage (Coke), the person will get coupons when checking out (comprising coupons from not only Coke, but also coupons from competitors: such as Pepsi and Dr. Pepper). Many people shop around at multiple stores before purchasing an item. When people want to buy furniture (such as office chairs, desks, beds), many people shop around at least three different stores before making a purchase. When a person is at store one, it would be great to receive coupons from competitors' stores, since the person was already going to look at multiple stores before deciding which store to make his purchases. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Jokinen* with the

commonly recognized practice of matching the location with a promotion that would be utilized at a competing location (competitor's store) as a cheap and efficient way for a competitor to advertise to the competitors' target audience, that is people who have already shown an interest in buying that kind of product (such as Coke or soda). Also, there are sponsored links when people do a google search. These companies (sponsored links) benefit by promoting their product, which may be a competitor to the store people were looking for when they searched on the internet. The rationale would have been for a competitor to cost-effectively market to potential future customers who have already shown an interest in buying that general kind of product, so the people are more likely to buy similar items at a competitors' store (competing location).

**Concerning Claim 21**, Jokinen discloses the invention substantially as claimed.

Jokinen does not teach the step wherein selecting the particular promotion further comprises matching the location with the particular promotion such that the particular promotion is utilized at another location unrelated to the location.

However, Official Notice is taken that the use of sending advertisements to people to use at a different location unrelated to the current location has been known as a basis for a company to advertise to new people, who may or may not be interested in companies' products. At a grocery store, when a person buys one brand of beverage (Coke), the person will get coupons when checking out (comprising coupons from not only Coke, but also coupons from products that a user has never purchased such as chips and salsa). A new company might only have one store in Washington, DC. This company will need to advertise in other states (other locations) if the company wants to sell products nationally. The company might want to advertise to all types of

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people, in order to sell products to anyone to grow and expand the company. For example, a company might give out advertisements (coupons) for running shoes to anyone in Los Angeles, even though the company (store) is only located in Washington, DC. Shoes are an item that everyone uses, so the fact that the promotion is at another location than the location of the store is not significant. If people like the shoes, they could simply buy the shoes over the internet. The company's location is unrelated to the location of the promotion or advertisements. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Jokinen* with the commonly recognized practice of matching the location with a promotion that is utilized at another location unrelated to the location of the promotion as a way to try and attract new customers (who may have never even considered buying this type of product). The potential customer may have never even heard of the product. The potential customer may be more likely to buy the product, since potential customer may not know of competitors who sell similar products. If coupons are used (promotion), people are even more likely to try out this product for the first time. Also, there are sponsored links on many websites. For example, the dating site True.com advertises many different unrelated places such as on [www.votefortheworst.com](http://www.votefortheworst.com) (trying to target as many people as possible, since anyone located anywhere might be interested in online dating). Since so many people might be interested in dating, the company sends advertisements to people, even without information that a person is interested in getting help to find a date. A company may choose to promote to other unrelated locations, different than where the company resides. A new, emerging company might not yet know who his target audience comprises. A company might want to simply build popularity of its name by getting the companies' name out to as many people as possible, as opposed to

specific target groups. A company promotes their generic product (without a need of checking to see if people are first looking for help in online dating or purchasing shoes) since so many different people are looking for help to spend money on these generic items, a company may choose the most cost-effective marketing technique is simply to send advertisements at a promotion location, which is totally unrelated to the location of the store. The rationale would have been for a store to target a whole new set of potential customers, including people who may have never even heard of the products being advertised or promoted, or to promote a generic product (such as online dating or shoes) that anyone might be interested in spending money on these generic items.

### ***Conclusion***

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 6,332,127 to Bandera et al. teaches system and methods for providing time and location specific advertising via the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Berman whose telephone number is (571) 270-3603. The examiner can normally be reached on Monday through Thursday 7:30 AM to 6:00 PM EST.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Berman/

Examiner, Art Unit 4194

3/14/2008

/Charles R. Kyle/

Supervisory Patent Examiner, Art Unit 4194